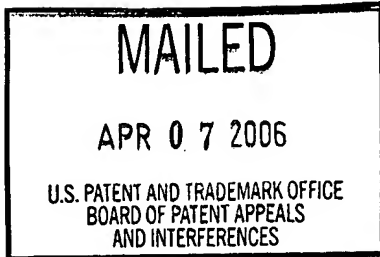


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte DANIEL BONE and PHILIP WREN



Appeal No. 2005-2606
Application No. 10/077,718

ON BRIEF

Before MCQUADE, CRAWFORD, and LEVY, Administrative Patent Judges.
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22 and 23, which are all of the claims pending in this application. Claims 1 through 21 have been canceled, claim 24 has been allowed and claims 25 through 28 have been withdrawn from consideration.

The appellants' invention relates to a clamping mechanism comprising a clamping arm which is rotatably mounted on the clamping mechanism by means of a one way rotary clutch such that the arm can freely rotate in one direction only wherein the center of mass of the clamping arm is spaced apart from the axis of rotation of the rotary one way clutch (specification, p. 9). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art

The prior art reference of record relied upon by the examiner in rejecting the appealed claim is:

Stoll	2,175,488	Oct. 10, 1939
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The rejection

Claims 22 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103 as being obvious over Stoll.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection, and to the brief and reply brief for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected the claims under 35 U.S.C. § 102(b) as being anticipated by Stoll. We initially note that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference.

The examiner is of the opinion that the subject matter of claim 22 is described in Stoll. Claim 22 is directed to a clamping mechanism which includes:

a clamping arm rotatably mounted on the rod, said clamping arm being rotatable through 360° about an axis of rotation, said clamping arm and said housing each defining a supporting surface for engaging said object.

Stoll discloses a foot rest. There is no disclosure in Stoll directed to a clamping mechanism or arm.

The examiner is of the opinion, however, that an object could be positioned between the concave surfaces of the arm 13 and upright 10 (answer at page 3) and that the language of claim 22 directed to a clamping arm relates to the intended use only and thus cannot serve to patentably distinguish the claimed invention over the prior art (final rejection at page 5).

We do not agree.

The preamble to claim 22 indicates that the invention is a clamping mechanism for clamping an object. The question of whether a preamble constitutes a limitation to a claim is a matter to be determined by the facts of each case in view of the claimed invention as a whole. See In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987). The preamble of a claim does not limit the scope of the claim when it merely states intended use of the invention. In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974). However, terms in a preamble are construed as limitations when they give life and meaning to the invention claimed. Gerber Garment Technology, Inc. v. Lectra Syst., Inc., 916 F.2d 683, 688, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (quoting) Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir.), cert. denied, 469 U.S. 857(1984). Although no "litmus test" exist as to what effect should be accorded to terms appearing in a preamble, a patent application in its entirety should be reviewed to determine whether the inventors intended such language to represent additional limitations or mere introductory

language. See, e.g., In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673-74 (Fed. Cir. 1994)(citing Corning Glass Works v. Suitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989).

In the instant case, our review of the appellants' specification indicates that the word "clamping mechanism" in the preamble was intended to be directed to a mechanism that clamp a branch while the branch is being cut by a saw. For instance, appellants' specification states:

. . . it is an object to provide a hand held reciprocating saw which allows the user to hold the saw with one hand without the need to hold the object to be cut with the other hand in order to prevent an oscillating movement of the object while it is cut [specification at page 5].

. . . the user only has to position the saw such that the branch can be held between support member and clamping arm [specification at page 6].

In addition, it is clear from a complete reading of appellants' specification, that the appellants intended the term "clamping mechanism" in claim 22 to be more than introductory language. In addition, the term "clamping arm" is positively recited in the body of the claim. In view of the foregoing, it is our view that the term "clamping mechanism" in the preamble breaths life and meaning into the claim and is not language of intended use.

Stoll does not describe a clamping arm. Rather, Stoll describes a foot rest having an arm 13 that can be rotated to adjust the height of the foot rest. In addition,

The decision of the examiner is reversed.


JOHN P. MCQUADE
Administrative Patent Judge


MURRIEL E. CRAWFORD
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge

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Appeal No. 2005-2606
Application No. 10/077,718

Page 7

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